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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,010	04/20/2000	Cary Lee Bates	IBM/138	4269

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EXAMINER

FRENEL, VANEL

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/553,010

Applicant(s)

BATES ET AL.

Examiner

Vanel Frenel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9, 13, 17-26, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13, 17-26, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Notice to Applicant***

1. *This communication is in response to the amendment filed 01/08/03. Claims 1, 17 and 29 have been amended. Claims 10-12, 14-16, and 27-28 have been cancelled. Claims 1-9, 13, 17-26 and 29-30 are pending.*

### ***Claim Rejections - 35 USC § 103***

2. Claims 1-9, 13, 17-26, and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMillan et al (6,064,970) in view of Keith et al (6,393,346), for substantially the same reasons given in the previous Office Action (paper 3), and further in view of Strong (6,006,148).

(A) Claim 1 has been amended to recite a method of conducting an economic transaction "associated with rental" of a vehicle over a period of time. The collective teachings of McMillan and Keith fail to expressly disclose transaction associated with rental" of a vehicle over a period of time. However, such a feature is well known in the art, as evidenced by Strong. In particular, Strong discloses an economic transaction "associated with rental" of a vehicle over a period of time (See Strong, Col. 12, lines 59-67 to Col.13, line 10).

One of ordinary skill in the art at the time of the invention would have found it obvious to incorporate the above features disclosed by Strong within the system taught collectively by McMillan and Keith with the motivation of providing information transmitted to the base station which then routed to a destination computer such as a

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computer inside the car rental building where the customer may pick up his/her receipt or to a computer on an airport shuttle bus which can also used to print out a receipt or otherwise finalize the customer transaction related to the vehicle drop-off. With the use of this automated vehicle return system, the added time and/ or costs associated with obtaining and processing the mileage, fuel tank information, and other data from a returned vehicle is minimized (See Strong, Col.1, lines 62-67 to Col.2, line 4).

The remaining features of claim 1 are rejected for the reasons set forth in the previous Office Action, and incorporated herein (Paper number 3, pages 7-8).

(B) The amendments to claims 17 and 29 reflect the same changes made to claim 1, discussed above, and are therefore rejected for the same reasons given above for claim1 in addition to the rejections made for claims 17 and 29 in the prior Office Action (Paper number 3, pages 7-8).

(C) Claims 2-9,13, 18-26, and 29-30 have not been amended and are rejected for the same reasons given in the previous Office Action (Paper number 3, pages 7-8).

### ***Response to Arguments***

3. Applicant's arguments filed on 01/08/03 with respect to claims 1-9, 13, 17-26, and 29-30 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed on 01/08/03 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 01/08/03.

(A) (1) At pages 9-11 of the 01/08/03 response, Applicant argues the McMillan does not disclose adjusting costs associated with a vehicle rental as recited in claim 1.

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(2) Furthermore, claim 1 is also non-obvious over McMillan et al., as there is no suggestion in the reference or elsewhere in the prior art to modify McMillan et al to adjust cost associated with vehicle rental.

(3) The Examiner has failed to raise a prima facie case of obviousness as to claim 1.

In response to Applicant's first argument, Examiner respectfully submits that Strong suggests "The host computer 52 would compare the current vehicle status data to the pre-rental vehicle status data and calculate a final charge for rental of the vehicle 32. The host computer 52 would then transmit the final charge along with an itemization of charges to the cash register 150. The cash register 150 would generate a bill which would be presented to the customer upon his/ her entering the rental agency 40 for completion of his vehicle rental transaction" which correspond to Applicant claimed feature (See Strong, Col.12, lines 19-67 to Col.13, line 10). Therefore, Applicant's argument is not persuasive.

In reponse to Applicant's second and third arguments, Examiner respectfully suggests that obviousness is not determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977F. 2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir.1992); *In re Piaseckii*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir.1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has

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presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (See paper number 3). Note, for example, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specially support that particular motivation and /or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is not seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one of ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, Ex parte Levengood, 28 USPQ2d 1300(Bd. Pat. App. & Inter., 4/22/93). Therefore, the combination of references is proper and the rejection is maintained.

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by

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their specific disclosures, In re Bozek, 163 USPQ 545 (CCPA 1969). Therefore, Applicant's argument is not persuasive.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches vehicle customization , restriction, and data logging (6,430,488); and method and apparatus for secure document timestamping (6,263,438); and car rent system (5,289,369).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on 6:00am-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

V.F

V.F

July 7, 2003

  
DINH X. NGUYEN  
PRIMARY EXAMINER